The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte, RICHARD CIAPALA, NICHOLAS P. DUANE,
CHRISTOPHER WARNER MCCARRON, and, KENNETH NILSEN

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Appeal No. 2007-0258
Application No. 10/053,376
Technology Center 2100

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Decided: February 6, 2007

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Before MAHSHID D. SAADAT, ALLEN R. MACDONALD, and
JEAN R. HOMERE, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the
Examiner's final rejection of claims 1-11 and 23-26.

THE INVENTION

The disclosed invention pertains to task tracing in a distributed computing environment. More particularly, the disclosed invention relates to an architecture that supports structured generation of event information by a running application, and focused tracing of tasks (Specification 1).

Representative claim 1 is illustrative:

1.   A method for tracing a computing task in a distributed computing environment, comprising:

at a first device, issuing a first call to invoke a first procedure to be executed at a second device that is different from said first device, said first call including tracing information instructing said second device to provide event information regarding the execution of said first procedure at the second device;

at said second device, receiving the first call and invoking the first procedure in response to said first call; and

at said second device, providing event information in accordance with said tracing information.

THE REFERENCES

The Examiner relies upon the following references as evidence in support of the rejections:

Morshed	US 6,760,903 B1	Jul. 6, 2004
Vasudevan	US 6,446,137 B1	Sep. 3, 2002

THE REJECTIONS

The following rejections are on appeal before us:

1. Claims 1-7, 9, and 23-26 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Morshed.

2. Claims 8, 10, and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Morshed in view of Vasudevan.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Brief and the Answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the Appellants' arguments set forth in the Brief along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon supports the Examiner's rejection of claims 1-11 and 23-26. Accordingly, we affirm.

Claim 1

Appellants argue that Morshed does not show the "out of band data" (col. 35, lines 18-31) contains an "instruction" to provide the event information recited in claim 1 (Br. 11).

The Examiner disagrees. The Examiner argues that Morshed's remote procedure call including the "out of band data" (i.e., tracing information) is an instruction from the client system (i.e., first device) to the server (i.e., second device) to gather execution data about a procedure executing on the server (Answer 4).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76, 77 USPQ2d 1321, 1325-26 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565, 24 USPQ2d 1321, 1326 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue "reads on" a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346, 51 USPQ2d 1943, 1945 (Fed Cir. 1999) ("In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.") (internal citations omitted).

After carefully considering the evidence before us, we conclude that the language of the claim (i.e., "tracing information instructing said second device") broadly but reasonably *reads on* Morshed's "out of band data." In

particular, we note that Appellants are arguing a limitation found in the specification that is not claimed. Specifically, an "instruction," per se, is not claimed. Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "'in view of the specification' without unnecessarily importing limitations from the specification into the claims") (internal citation omitted).

In the instant case, we find that Morshed's "out of band data" (i.e., tracing information) is subsequently extracted on the server side (i.e., on the second device) and may be used (i.e., in an instructive capacity) to gather execution data (i.e., provide event information) about the distributed application as a whole as well as components of the distributed application that may execute on different computer systems (col. 35, ll. 27-31). Therefore, we conclude the preponderance of the evidence shows that claim 1 is anticipated by Morshed. Accordingly, we will sustain the Examiner's rejection of claim 1 as being anticipated by Morshed.

Claims 3-7, and 9

Appellants have not presented any substantive arguments directed separately to the patentability of dependent claims 3-7, and 9. In the absence of a separate argument with respect to the dependent claims, those claims stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii). Therefore, we will sustain the Examiner's

rejection of these claims as being anticipated by Morshed for the same reasons discussed *supra* with respect to claim 1.

Claims 2, 23, and 25

Appellants argue that Morshed's "out of band data" is not tracing information that specifies a limitation on the content of event information to be provided. Appellants further argue that Morshed's "out of band data" is: (1) not limited by a requirement that originates from the application program, and, (2) not limited by a limitation requirement that is sent from the first computing device to the second computing device (Br. 12-13).

The Examiner disagrees. The Examiner argues that Morshed's "out of band data" (i.e., tracing information) instructs the called function (i.e., server function) as to what range of information to gather thereby limiting the information returned to the caller (Answer 4).

We find that Morshed's "out of band data" is application program tracing information sent from a first computing device to a second computing device that specifies a limitation on the content of event information (i.e., execution data) to be provided. We note that Morshed's "out of band data" is described in greater detail at col. 43, l. 51 through col. 44, l. 7. Specifically, Morshed discloses that the information communicated from the client process to the server process may include, e.g., (1) the process identifier of the calling process, (2) an address of the calling routine within the calling process, and, (3) system information serving to identify the computer system upon which the client software executes (*id.*). We find that such information would at least associate (i.e., limit) the execution data

resulting from the Remote Procedure Call (RPC) to execution data that corresponds to the calling client session or process (*See* Morshed, col. 34, l. 66, and col. 35, l.62 through col. 36, l. 3). Therefore, we find the weight of the evidence supports the Examiner's position that tracing information (i.e., "out of band data") communicated from the client process to the server process limits the event information provided by the server to execution data (i.e., event information) associated with the client's calling routine (i.e., Remote Procedure Call) when the RPC executes on the server. *See also* Morshed's discussion of collecting execution data associated with a particular session of data (i.e., client process) (col. 35, l. 56 through col. 36, l. 3). Therefore, we conclude the preponderance of the evidence shows that claims 2, 23, and 25 are anticipated by Morshed. Accordingly, we will sustain the Examiner's rejection of these claims as being anticipated by Morshed.

Claims 24 and 26

Appellants have not presented any substantive arguments directed separately to the patentability of dependent claims 24 and 26. In the absence of a separate argument with respect to the dependent claims, those claims stand or fall with the representative independent claim. *See In re Young*, 927 F.2d at 590, 18 USPQ2d at 1091. *See also* 37 C.F.R. § 41.37(c)(1)(vii). Therefore, we will sustain the Examiner's rejection of dependent claims 24 and 26 for the same reasons discussed *supra* with respect to independent claims 23 and 25, respectively.

Claims 10 and 11

Appellants argue that neither Morshed nor Vasudevan teaches or suggests calling a procedure whose identity or location is undetermined at the time of the call (Br. 14).

The Examiner disagrees. The Examiner points to the breadth of the supporting instant Specification and asserts that the language of the claim reads on Vasudevan when Appellants' claim is properly construed in light of the instant Specification (Answer 5).

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In the instant case, we find that Vasudevan teaches calling a procedure whose identity or location is undetermined at the time of the call. In particular, we note that Vasudevan explicitly discloses: "The remote procedure call is 'virtual' because the client stub does not have the specific implementation that marshals the argument at the time of the call" (col. 3, ll. 33-35). Thus, we conclude the Examiner has met the required burden of presenting a prima facie case of unpatentability. Accordingly, we will sustain the Examiner's rejection of claims 10 and 11 as being unpatentable over Morshed in view of Vasudevan.

Claim 8

We will sustain the Examiner's rejection of claim 8 as being unpatentable over Morshed in view of Vasudevan for the same reasons discussed *supra* with respect to claims 10 and 11.

SUMMARY

In summary, we have sustained the Examiner's rejection of all claims on appeal. Therefore, the Examiner's decision rejecting claims 1-11 and 23-26 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED.

pgc/ce

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